

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRION JACKSON
and MARVIN WILLIAMS

Appeal No. 96-1082
Application 08/275,882¹

ON BRIEF

Before URYNOWICZ, JERRY SMITH, and BARRETT, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed July 15, 1994. According to appellants, this application is a continuation of Application 07/779,024, filed October 18, 1991.

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 10-17, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method for displaying a preview of a text string as it will actually appear on a peripheral device, such as a printer, based on the nature of the application running and the selected peripheral device. More particularly, query parameters are used to access a table which stores bit maps containing a facsimile response of a combination of an application and a peripheral device.

Representative claim 10 is reproduced as follows:

10. A method of assembling an image for display of a combined response of at least an application and a peripheral device from bit maps of image data including the steps of

determining at least one of first, second and third query parameters in accordance with at least one of said application and said peripheral device,

obtaining a table address in response to a query portion containing first and second query parameters,

addressing at least one bit map containing a facsimile response of a combination of an application and a peripheral device in response to said table address, a text string and a third query parameter, and

displaying said at least one bit map.

Appeal No. 96-1082
Application 08/275,882

The examiner relies on the following references:

Boulia et al. (Boulia)	4,594,674	June 10, 1986
Torres	5,001,697	Mar. 19, 1991

In the final rejection claims 10-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by a patent granted to Rush [4,686,649]. Claims 10-17 were also rejected under 35 U.S.C. § 103 as being unpatentable over "Torres and Boulia in view of Rush." In response to the appeal brief, the examiner withdrew the rejections based upon Rush [answer, page 2]. Claims 10-17 now stand rejected under 35 U.S.C. § 103 as being unpatentable over "Torres... and Boulia" [Id. at page 3]. Although the examiner refers to the combined teachings of Torres and Boulia with respect to claims 16 and 17, the examiner also reads each of claims 10-15 on Boulia and reads each of claims 10-17 on Torres in an anticipatory manner.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

Appeal No. 96-1082
Application 08/275,882

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 10-17. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been

Appeal No. 96-1082
Application 08/275,882

led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In the final rejection of the claims under 35 U.S.C. § 103, the examiner basically took the position that Boulia and Torres disclosed the invention as claimed except for the facsimile response of the addressing step (claim 10) and the retrieving step (claim 14). The examiner relied on Rush to support the obviousness of this feature of the claims. Since

Appeal No. 96-1082
Application 08/275,882

Rush is no longer relied upon in the rejection of the claims, the examiner now asserts that the claimed facsimile response is disclosed in both the Boulia and Torres references. The examiner has also now read the claimed invention on the disclosures of Boulia and Torres in an anticipatory manner.

The original appeal brief is primarily directed to pointing out the inadequacies of the Rush reference which was relied on for all the rejections in the final rejection. Appellants also pointed out in the original brief, however, that there is no teaching or suggestion in Torres of a facsimile response which combines an application and a peripheral device as claimed. With respect to Boulia, appellants argued that there is also no teaching therein of a facsimile response which combines applications with peripheral devices.

The examiner responded to appellants' arguments by reiterating that Boulia and Torres teach "facsimile response" in the sense of "exact copy or likeness" [answer, page 12]. Appellants responded that the devices of Boulia and Torres do not provide a facsimile response of a combination of an

Appeal No. 96-1082
Application 08/275,882

application and a peripheral device as recited in the appealed claims.

We agree with appellants. In our view, the examiner has not properly interpreted the scope of the claimed invention nor the disclosures of Boulia and Torres. A critical feature of independent claims 10 and 14 is that the stored bit maps contain "a facsimile response of a combination of an application and a peripheral device." We construe this claim language as requiring that the stored bit maps be a function of both the application running and a peripheral device upon which the information is to be generated. Although the examiner asserts that this condition is present in Boulia and Torres, we agree with appellants that the claimed feature quoted above is not suggested by Boulia and Torres, whether considered individually or together.

Although we consider the stored bit maps of Boulia and Torres to be a facsimile response of "something", that something is not a combination of an application and a peripheral device. The bit maps stored in Boulia and Torres are based on information derived only from the selected font and items related to that font. There is no suggestion in

Appeal No. 96-1082
Application 08/275,882

Boulia or Torres that the stored bit maps are different based on the application running or on an attached peripheral device or on a combination thereof. Although Boulia and Torres suggest that data is displayed and/or printed, the stored bit maps which are displayed are not a function of a combination of an application and a peripheral device as claimed.

Since the examiner has not properly addressed the differences between the claimed invention and the teachings of the applied references, the examiner has failed to establish a prima facie case of the obviousness of the appealed claims.

Therefore, the decision of the examiner rejecting claims 10-17 under 35 U.S.C. § 103 is reversed.

REVERSED

	STANLEY M. URYNOWICZ, JR.)	
	Administrative Patent Judge)	
)	
)	
	JERRY SMITH)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	LEE E. BARRETT)	
	Administrative Patent Judge)	

Appeal No. 96-1082
Application 08/275,882

JS/cam

Appeal No. 96-1082
Application 08/275,882

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